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APPEAL BRIEF UNDER 37 C.F.R. §41.37
Application Serial No. 09/747,651
Attorney Docket No. 031792-0311567

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPELLANT(S) : Eugene J. Rollins, *et al.* CONFIRMATION No.: 9835
SERIAL NUMBER : 09/747,651 EXAMINER : Michael Kyle
FILING DATE : December 22, 2000 ART UNIT : 3676
FOR : PRE-FILLING ORDER FORMS FOR TRANSACTIONS OVER A COMMUNICATIONS
NETWORK

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Appellants' Appeal Brief Under 37 C.F.R. §41.37

Sir:

Further to the Notice of Appeal filed on September 7, 2004, Appellants herewith submit an Appeal Brief pursuant to 37 C.F.R. §41.37.

In accordance with §41.20, the amount of \$500.00 representing the fee for filing an Appeal Brief is attached. It is believed that no other fees are due in connection with this submission beyond those that otherwise may be provided for in documents accompanying this paper. However, if it is determined otherwise, the Commissioner is authorized to credit any overpayment or charge any deficiencies to the undersigned's account, Deposit Account No. 033975, Reference No. 031792-0311567.

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I. REAL PARTY IN INTEREST.

The real party in interest is e-centives, Inc. by virtue of the assignment recorded at Reel 011680, Frame 0858.

II. RELATED APPEALS AND INTERFERENCES.

Based on information and belief, there are no related appeals or interferences.

III. STATUS OF CLAIMS.

Pending: Claims 1-31 are pending.

Rejected: Claims 1-31 stand rejected.

Allowed: No claims have been allowed.

On Appeal: Claims 1-31 are appealed.

IV. STATUS OF AMENDMENTS.

No amendments to the claims were submitted subsequent to the final rejection of the claims. However a reply was submitted on July 6, 2004 presenting arguments and a supplemental reply was submitted July 13, 2004 to address typographical errors in the listing of claims presented in the reply of July 6, 2004.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER.

Appellant's invention comprises a system and method for processing requests from a client for electronic documents located at a server. According to an embodiment of the invention, a user request for electronic documents may be received by an intermediary, which retrieves the documents from the server and forwards the documents to the client. For example, the system may include a client device (303) viewing information via a web browser, a web server (306) storing electronic documents, and an intermediary (308) disposed between the client device and web server. See Specification *e.g.*, page 9, and Figure 3.

According to an embodiment of the invention, the user request for a document stored on the server is received at the intermediary. The intermediary retrieves the electronic document. The retrieved document may include data fields. The intermediary may generate an updated electronic document updating the data fields based on information associated with the user. In some embodiments, this may include determining whether the electronic document contains valid user data and if not, revising the electronic document by substituting data values from the user information for the corresponding variables. See Specification e.g., pp. 9-10. According to some embodiments of the invention, a tracer image may be used to retrieve information associated with the user. See Specification e.g., page 9.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL.

Claims 1-2, 4, 6, 8-10, 12-16, 18, 20, 22-24 and 26-29 stand rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Markus (U.S. patent No. 6,499,042). Claims 3 and 17 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Markus '042 in view of Markus et al. (U.S. Patent No. 6,490,601). Claims 5, 11, 19 and 25 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Markus '042 in view of Wong (U.S. Patent No. 5,956,699). Claims 7 and 21 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Markus '042 in view of Rhoads (U.S. Patent No. 6,285,776).

VII. ARGUMENT

Each rejection should be reversed for the reasons set forth herein.

A. Claims 1, 2, 4, 6, 8-10, 12-16, 18, 20, 22-24, and 26-29 are Patentable under 35 U.S.C. § 102(e)

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051,

1053 (Fed. Cir. 1987). Further, MPEP § 2131.02 states that “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Claims 1, 2, 4, 6, 8-10, 12-16, 18, 20, 22-24, and 26-31 are patentable under 35 U.S.C. § 102(e) over U.S. Patent No. 6,499,042 to Markus (“Markus ‘042”) because Markus ‘042 fails to disclose each and every claim element.

Independent Claims 1, 15, and 29

Independent claims 1 recites, among other things, “a method of **processing requests from a client** for electronic documents located at a server” comprising “receiving, **by an intermediary** disposed between the client and the server, a request **from the client** for an electronic document located at a first address at the server, **the request made by a user at the client**” (*Emphasis Added*). Independent claims 15 and 29 recite similar features. At least these features are not disclosed by Markus ‘042. In fact, Markus ‘042 describes a completely different system where a user request for a document is made directly from a document browser to a document server (column 3, lines 22-27).

The Examiner refers to column 3, lines 29-31 of Markus ‘042, alleging that Markus ‘042 teaches receiving, by an intermediary, a request for a document located at a server and that the request is made by a user at the client. However, it appears that the Examiner has ignored the preceding lines which specifically recite that the external entity instructs the document browser to fetch the desired document, the document browser then contacts the document server to request the document, and the document server returns the requested document. The Examiner apparently interprets the document browser described in Markus ‘042 as the client as claimed by the Appellant, the selective proxy described by Markus ‘042 as the intermediary as claimed by the Appellant, and the document server described by Markus ‘042 as the server as claimed by the Appellant (see Final Office Action, page 6).

In accordance with the Examiner’s interpretation, a user instructs a document browser to request a desired document. The document browser then contacts a

document server to request a document which is returned by the document server to the document browser and on to the user. If the user then desires to have the already retrieved document automatically filled, the user activates an auto-fill trigger which causes the document browser to contact the selective proxy to retrieve the information. Once the user has entered login information, the selective proxy then contacts the document server and requests the same document already requested and obtained by the document browser. See Markus '042, column 3. Even under the interpretation of Markus '042 set forth by the Examiner, Markus '042 fails to disclose the claimed features because the request for an auto-fill operation, as described by Markus '042, is not a request by the user for a document at the server, as set forth in claims 1, 15, and 29.

When read fairly, Markus '042 apparently discloses that once a user has retrieved a desired document directly from the document server, the user may then request that the already retrieved document go through an auto-fill process. Markus '042 expresses that "the Selective Proxy contacts the same Document Server and the Document Browser connected in 14 and requests the exact same document." See column 3, lines 36-44. However, neither the request to have the document auto-filled is made by the user or the request made by the selective proxy for its version of the document is the same as a request from a user at the client for a document. A

Thus, Markus '042 does not disclose at least these features of the invention. Thus, claim 1 is not anticipated by Markus '042. Independent claims 15 and 29 recite similar features and are therefore also not anticipated by Markus '042 for at least the same reasons.

Dependent Claims 2, 4, 6, 8 -10, 12, 16, 18, 20, 22 - 24, 26, 30, and 31

Dependent claims 2, 4, 6, 8, 10 -12, 16, 18, 20, 22 - 24, 26, 30, and 31 depend from and add features to one of independent claims 1, 15, and 29. As such, these dependent claims are allowable over Markus '042 for at least the reasons set forth above.

Dependent Claims 13 and 27

Claims 13 and 17 depend from one of dependent claims 1 and 15. As such, claims 13 and 17 are not anticipated by Markus '042 at least due to this dependency. Furthermore, dependent claims 13 and 27 recite, among other things, "when the one or more variables are determined not to include valid user data, revising the electronic document by substituting one or more data values" The Examiner asserts that "a blank field is not valid user data" and "Markus '042 fills blank fields with valid user data." However, filling blank field is clearly not the same as revising invalid data field. For at least this additional reason, claims 13 and 17 are not anticipated by Markus '042.

Dependent Claims 14 and 28

Claims 14 and 28 depend from and add additional features to one of independent claims 1 and 15. As such, claims 14 and 28 are not anticipated by Markus '042 at least due to this dependency. Furthermore, dependent claims 14 and 28 recite, among other things, "examining a context in which each of the one or more variables is used in the electronic document" and "identifying a particular data value from the plurality of data values, wherein the particular data value conforms to the context" At least these features are not disclosed by Markus '042. In fact, the Examiner makes no attempt to refer to any specific portions of Markus '042 for disclosing these features because Markus '042 does not disclose these features. For at least this additional reason, claims 14 and 28 are not anticipated by Markus '042.

B. Claims 3, 5, 7, 11, 17, 19, 21, and 25 are Patentable under
35 U.S.C. § 103(a)

In order to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 985 (C.C.P.A. 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385 (C.C.P.A. 1970).

Additionally, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988).

Claims 3 and 17

Claims 3 and 17 are patentable under 35 U.S.C. §103(a) over Markus '042 in view of U.S. Patent No. 6,490,601 to Markus et al ("Markus '601"). In particular, the combination of Markus '042 and Markus '601 fail to address the deficiencies of Markus '042 as set forth above. As such, claims 3 and 17 are allowable over Markus '042 and Markus '601 for at least their dependency on one of claims 1 and 15.

Claims 5 and 19

Claims 5 and 19 are patentable over Markus '042 in view of U.S. Patent No. 5,956,699 to Wong. In particular, the combination of Markus '042 and Wong fails to address the deficiencies of Markus '042 as set forth above.

Furthermore, claims 5 and 19 recite "storing the information associated with the user in an encrypted format." The Examiner acknowledges that Markus '042 fails to disclose this feature and relies on Wong to overcome this deficiency. Wong appears to be directed towards providing a personal charge number to a user for use in electronic commerce in place of the user's actual personal account information (see Wong, column 5, lines 43-46). According to Wong, this personal charge number may apparently be encrypted when used in a transaction. However, Wong does not suggest storing a user's information in an encrypted format. As such, claims 5 and 19 are allowable over Markus '042 in view of Wong for the additional features presented as well.

Claims 11 and 25

Claims 11 and 25 are patentable over Markus '042 in view of U.S. Patent No. 5,956,699 to Wong. In particular, the combination of Markus '042 and Wong fails to address the deficiencies of Markus '042 as set forth above.

Furthermore, claims 11 and 25 recite “receiving information associated with the user from an encrypted wallet cookie.” The Examiner acknowledges that Markus ‘042 fails to disclose this feature and relies on Wong to overcome this deficiency. Wong appears to be directed towards providing a personal charge number to a user for use in electronic commerce in place of the user’s actual personal account information (see Wong, column 5, lines 43-46). This personal charge number may be encrypted when used in a transaction. However, Wong does not even suggest storing a user’s information in an encrypted format. As such, claims 11 and 25 are allowable over Markus ‘042 in view of Wong for the additional features presented, as well.

Claims 7 and 21

Claims 7 and 21 are patentable under 35 U.S.C. § 103(a) over Markus ‘042 in view of U.S. Patent No. 6,285,776 to Rhoads (“Rhoads”). Claims 7 and 21 are patentable for *at least* the reasons that: (1) the Examiner relies on non-analogous art for the rejection of claims 7 and 21; and (2) assuming arguendo that the art is not deemed non-analogous, the references, even if combined, fail to disclose, teach, or suggest all of the claim elements.

The Examiner Relies on Non-Analogous Art

The Examiner’s reliance on Rhoads for the rejections of claims 7 and 21 is improper as this reference is non-analogous art to Appellants’ claimed invention.

A two step test has been developed to determine whether a particular reference is within the appropriate scope of the prior art. First, it must be determined whether a particular reference is “within the field of the inventor’s endeavor.” Second, assuming the reference is outside that field, it must be determined whether the reference is “reasonably pertinent to the particular problem with which the inventor was involved.” *In re Deminski*, 796 F.2d 436 (Fed. Cir. 1986).

Rhoads is outside the inventor’s field of endeavor for at least the reason that the reference does not relate to the relevant field of endeavor. The inventor’s field of endeavor for claims 7 and 21 relate to the use of an intermediary to facilitate communications in a communications network and the retrieval of electronic documents

from a server via an intermediary upon request by a client. Rhoads is directed towards methods of identifying equipment used in counterfeiting banknotes. See Rhoads *e.g.*, abstract. This is not within the field of endeavor of the inventor.

Furthermore, Rhoads is not reasonably pertinent to the particular problems with which Appellant were involved. These problems included problems associated with processing orders over the Internet including the completion of order forms and the payment of commissions to shopping applications and portals. Rhoads, on the other hand, is concerned with problems such as the reproduction and counterfeiting of banknotes. Since Rhoads is neither in the same field of endeavor as Appellant's invention nor concerned with solving the same problems, the use of Rhoads in rejecting claims 7 and 21 is improper. As such, claims 7 and 21 are allowable.

The references, even if combined, fail to disclose, teach, or suggest all of the claim elements

Claims 7 and 21 are patentable over Markus '042 in view of Wong. In particular, the combination of Markus '042 and Wong fails to address the deficiencies of Markus '042 as set forth above.

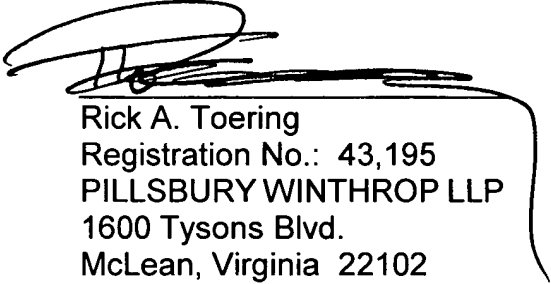
Furthermore, claims 7 and 21 recite, among other things, "receiving, via a tracer image, information associated with the user." The Examiner acknowledges that Markus '042 fails to disclose this feature and relies on Rhoads to overcome this deficiency (see Final Office Action, page 5). Rhoads appears to be directed towards preventing counterfeiting of banknotes by inserting forensic tracer data into an image of a banknote when the note is copied (see Abstract). Apparently, any printed output from the image will include the tracer data, making it possible to identify the equipment used in its reproduction (see column 2, lines 65-67). However, Rhoads does not suggest receiving information associated with the user via a tracer image. As such, claims 7 and 21 are allowable over Markus '042 and Rhoads for the additional features presented, as well.

VIII. CONCLUSION

Because the references relied upon by the Examiner, either alone or in combination with one another, fail to disclose, teach or suggest all of the features of the claims as set forth above, and/or because the Examiner has applied non-analogous references, the rejection of each of pending claims must be reversed.

Dated: January 7, 2005

Respectfully submitted,



Rick A. Toering
Registration No.: 43,195
PILLSBURY WINTHROP LLP
1600 Tysons Blvd.
McLean, Virginia 22102
703-905-2000

A. CLAIMS APPENDIX

1. (Previously Presented) A method for processing requests from a client for electronic documents located at a server, the method comprising the computer-implemented steps of:

receiving, by an intermediary disposed between the client and the server, a request from the client for an electronic document located at a first address at the server, the request made by a user at the client;

retrieving, by the intermediary, the electronic document from the first address;

retrieving, by the intermediary, information associated with the user;

generating an updated electronic document from the retrieved electronic document, said updated electronic document including at least a portion of the information associated with the user; and

providing the updated electronic document to the client for the user in response to the request.

2. (Original) The method of Claim 1, further comprising the steps of:

receiving validation data from the user, and

validating the validation data.

3. (Original) The method of Claim 1, further comprising the step of:

storing the information associated with the user such that the information may be used with one or more other electronic documents.

4. (Original) The method of Claim 1, further comprising the step of:

storing the information associated with the user via an Internet cookie.

5. (Original) The method of Claim 1, further comprising the step of:

storing the information associated with the user in an encrypted format.

6. (Original) The method of Claim 1, wherein the electronic document is a web page, and the updated electronic document is an updated web page generated by an integrated order mechanism.

7. (Original) The method of Claim 1, wherein the step of retrieving information associated with the user further comprises the step of: retrieving, via a tracer image, information associated with the user.

8. (Original) The method of Claim 1, wherein the step of retrieving information associated with the user further comprises the step of: retrieving, via a post from a server, information associated with the user.

9. (Original) The method of Claim 1, wherein the request from the user is received at an intermediary, wherein the electronic document is stored on a server, and wherein the step of retrieving the electronic document comprises the steps of: sending a new request from the intermediary to the server; and receiving, at the intermediary, the electronic document from the server in response to the new request.

10. (Original) The method of Claim 1, wherein the step of retrieving information associated with the user comprises the step of: retrieving information associated with the user from a wallet server.

11. (Original) The method of Claim 1, wherein the step of retrieving information associated with the user comprises the step of: retrieving information associated with the user from an encrypted wallet cookie.

12. (Original) The method of Claim 1, wherein the electronic document includes one or more data fields, and wherein the step of generating the updated electronic document comprises the step of:

generating, based upon the electronic document, the updated electronic document by updating the one or more data fields based upon the information associated with the user.

13. (Original) The method of Claim 1, wherein the step of generating the updated electronic document further comprises the steps of:

determining whether one or more variables included in the electronic document include valid user data; and

when the one or more variables are determined to not include valid user data, revising the electronic document by substituting one or more data values from the information associated with the user for the one or more variables.

14. (Original) The method of Claim 1, wherein the information associated with the user is comprised of a plurality of data values, wherein the electronic document includes one or more variables, and wherein the method further comprises the steps of:

determining whether each of the one or more variables in the electronic document corresponds to at least one of the plurality of data values;

when each of the one or more variables does not correspond to at least one of the plurality of data values, performing the steps of:

examining a context in which each of the one or more variables is used in the electronic document;

identifying a particular data value from the plurality of data values, wherein the particular data value conforms to the context in which each of the one or more variables is used; and

substituting the particular data value for each of the one or more variables in the electronic document.

15. (Previously Presented) A computer-readable medium for processing requests from a client for electronic documents located at a server, the computer-readable medium carrying one or more sequences of one or more instructions which, when executed by one or more processors, cause the one or more processors to perform the steps of:

receiving, by an intermediary disposed between the client and the server, a request from the client for an electronic document located at a first address at the server, the request made by a user at the client;

retrieving, by the intermediary the electronic document from the first address;

retrieving, by the intermediary, information associated with the user;

generating an updated electronic document from the retrieved electronic document, said updated electronic document including at least a portion of the information associated with the user; and

providing the updated electronic document to the client for the user in response to the request.

16. (Original) The computer-readable medium of Claim 15, further comprising instructions which, when executed by one or more processors, cause the one or more processors to carry out the steps of:

receiving validation data from the user, and

validating the validation data.

17. (Original) The computer-readable medium of Claim 15, further comprising instructions which, when executed by one or more processors, cause the one or more processors to carry out the step of:

storing the information associated with the user such that the information may be used with one or more other electronic documents.

18. (Original) The computer-readable medium of Claim 15, further comprising instructions which, when executed by one or more processors, cause the one or more processors to carry out the step of:

storing the information associated with the user via an Internet cookie.

19. (Original) The computer-readable medium of Claim 15, further comprising instructions which, when executed by one or more processors, cause the one or more processors to carry out the step of:

storing the information associated with the user in an encrypted format.

20. (Original) The computer-readable medium of Claim 15, wherein the electronic document is a web page, and

the updated electronic document is an updated web page generated by an integrated order mechanism.

21. (Original) The computer-readable medium of Claim 15, wherein the step of retrieving information associated with the user further comprises instructions which, when executed by one or more processors, cause the one or more processors to carry out the step of:

retrieving, via a tracer image, information associated with the user.

22. (Original) The computer-readable medium of Claim 15, wherein the step of retrieving information associated with the user further comprises instructions which, when executed by one or more processors, cause the one or more processors to carry out the step of:

retrieving, via a post from a server, information associated with the user.

23. (Original) The computer-readable medium of Claim 15, wherein the request from the user is received at an intermediary, wherein the electronic document is stored on a server, and wherein the step of retrieving the electronic document further comprises instructions which, when executed by one or more processors, cause the one or more processors to carry out the steps of:

sending a new request from the intermediary to the server; and receiving, at the intermediary, the electronic document from the server in response to the new request.

24. (Original) The computer-readable medium of Claim 15, wherein the step of retrieving information associated with the user further comprises instructions which, when executed by one or more processors, cause the one or more processors to carry out the step of:

retrieving information associated with the user from a wallet server.

25. (Original) The computer-readable medium of Claim 15, wherein the step of retrieving information associated with the user further comprises instructions which, when executed by one or more processors, cause the one or more processors to carry out the step of:

retrieving information associated with the user from an encrypted wallet cookie.

26. (Original) The computer-readable medium of Claim 15, wherein the electronic document includes one or more data fields, and where in the step of generating the updated electronic document further comprises instructions which, when executed by one or more processors, cause the one or more processors to carry out the step of:

generating, based upon the electronic document, the updated electronic document by updating the one or more data fields based upon the information associated with the user.

27. (Original) The computer-readable medium of Claim 15, wherein the step of generating the updated electronic document further comprises instructions which, when executed by one or more processors, cause the one or more processors to carry out the steps of:

determining whether one or more variables included in the electronic document include valid user data; and

when the one or more variables are determined to not include valid user data, revising the electronic document by substituting one or more data values from the information associated with the user for the one or more variables.

28. (Original) The computer-readable medium of Claim 15, wherein the information associated with the user is comprised of a plurality of data values, wherein the electronic document includes one or more variables, and wherein the computer-readable medium further comprises instructions which, when executed by one or more processors, cause the one or more processors to carry out the steps of:

determining whether each of the one or more variables in the electronic document corresponds to at least one of the plurality of data values;

when each of the one or more variables does not correspond to at least one of the plurality of data values, performing the steps of:

examining a context in which each of the one or more variables is used in the electronic document;

identifying a particular data value from the plurality of data values, wherein the particular data value conforms to the context in which each of the one or more variables is used; and

substituting the particular data value for each of the one or more variables in the electronic document.

29. (Previously Amended) A system for processing requests from a client for electronic documents located at a server, the system comprising:

an intermediary disposed between the client and the server; and

a server that is associated with an electronic document located at a first address at the server;

wherein the intermediary, in response to a request from the client made by a user at the client for the electronic document, retrieves both the electronic document from the server first address and information associated with the user, and

wherein the intermediary generates an updated electronic document from the retrieved electronic document, said updated electronic document including at least a portion of information associated with the user.

30. (Previously Presented) The method of claim 1 wherein the intermediary is neither the client or the server.

31. (Previously Presented) The computer-readable medium of claim 15 wherein the intermediary is neither the client or the server.